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09/704,254	11/01/2000	Blaine Garst	10010.1070C	3557

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EXAMINER	
GREENE, DANIEL LAWSON	

ART UNIT	PAPER NUMBER
3694	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/704,254	GARST ET AL.	
	Examiner	Art Unit	
	Daniel L. Greene Jr.	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *84-92 and 94-147* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *84-92 and 94-147* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 84-92 and 94-147 are pending.

2. Applicant's change of address received 10/31/2006 is acknowledged.

3. It is noted that Mr. Todd Snyder conducted an interview with Examiner Sherr on 10/3/2006 and Examiner Sherr indicated allowable subject matter. However upon further review and subsequent search, the previously indicated allowability is withdrawn. Any inconvenience to applicant is regretted.

4. Mr. Snyder and Examiner Sherr agreed to the following changes to the claims on said 10/03/2006 interview.

a. **In claim 84, change –**

". . . an access authorization indicator associating a software program and a software resource, said access authorization indicator comprising one or more license terms to allow said software program to use said software resource; and

a digital signature of said access authorization indicator."

to:

". . . means for using an access authorization indicator associating a software program and a software resource, said access authorization indicator comprising a plurality of license terms to allow said software program to use said software resource; and

a digital signature of said access authorization indicator."

b. **In claim 106, change –**

". . . access authorization indicator comprising one or more license terms to allow said software program to use . . . "

to:

". . . access authorization indicator comprising a plurality of license terms to allow said software program to use . . ."

c. **In claim 127, change –**

". . . access authorization indicator comprising one or more license terms to allow said software program to use . . . "

to:

". . . access authorization indicator comprising a plurality of license terms to allow said software program to use . . ."

Accordingly, said changes should be reflected within applicant's response to the instant Office action by amending said claims accordingly. However in the interest of compact prosecution the instant Office action will address these claims as if they have already been amended, that is, since it was previously agreed to amend the wording of the claims, these claims have been examined as if the amendments had already been made and the claims read as set forth immediately above.

5. Applicants submission and subsequent approval of the 7/5/2005 terminal disclaimer is acknowledged and obviates the rejections set forth in sections 3-9 (note NO section 4 exists) of the previous Office action mailed 6/16/2005. Accordingly, said rejections are withdrawn.

6. Although the previous rejections have been withdrawn, upon further review new art has been discovered and applied to the claims as explained in detail below.

7. Accordingly an action on the merits of claims 84-92 and 94-147 follows.

Priority

8. It is noted that this application appears to claim subject matter disclosed in prior Application No. 08/901,776, filed 7/28/1997. Applicant's 11/01/2000 supplemental submission is not considered proper in that it does not contain the status of the parent application.

A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the

application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge

under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Objections

9. Claims 88, 94, 110, 115, 123, 131, 136, objected to because of the following informalities:

a. **Claims 88, 94, 110, 115, 131 and 136 contain abbreviations** (i.e. API, and OLE). The abbreviations are improper and should be replaced with their appropriate language. If applicant wishes to maintain the abbreviations, then the claims should be amended to include the extended language of said abbreviations, i.e. Application Program Interface (API) and Object Linking and Embedding (OLE) as appropriate. This change is required because the abbreviations may be redefined at some point in the future to mean something totally different than their current intended meaning, at which point their true meaning might be lost.

b. **Claim 123 contains a typographical error**. The limitation "a property of a property of property list area". This appears to either be a typo because the specification as filed does not contain such wording AND claim 138, which mirrors claim 123, only claims "a property of property list area".

Appropriate correction is required.

Claim Rejections - 35 USC § 102and 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 84-92 and 94-104 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wyman (U.S. Patent 5,204,897) in view of Applicants Admitted Prior Art (APA).

Regarding claim 84 - Wyman discloses, in a computer operating environment comprising a software program and a software resource, an apparatus for limiting use of said software resource by said software program and a software resource,

comprising: means for using an access authorization indicator associating a software program and a software resource, said access authorization indicator comprising a plurality of license terms to allow said software program to use said software resource; and a digital signature of said access authorization indicator in, for example, the abstract, col. 14 lines 26+ and col. 15 lines 1-16.

Regarding claim 85 - Wyman discloses the apparatus of claim 84 further comprising: means in said software resource for reading said access authorization indicator; means in said software resource for determining whether said access authorization indicator is valid; and, means for allowing said software program to use said software resource only if said access authorization indicator is determined to be valid in, for example, Col 6 In 54-58.

Regarding claim 86 - Wyman discloses the apparatus of claim 84 wherein said access authorization indicator comprises terms of a site license in, for example, Col 6 In 54-58.

Regarding claim 87 - Wyman discloses the apparatus of claim 84 wherein said access authorization indicator is embedded in said software program in, for example, Col 6 lines 54+ through Col 7 line 2.

Regarding claim 88 - Wyman discloses the apparatus of claim 84 wherein said software resource comprises an API (e.g. col 27 ln 23-31).

Regarding claim 89 - Wyman discloses the apparatus of claim 84 wherein said software resource comprises a runtime library in, for example, Col 4 ln 52+ wherein it is understood that the term relational database runtime system reads on the limitation "runtime library".

Regarding claims 88-92, 94, 110-115 and 131-136 it must be noted that these claims are all directed towards obvious variants of computer related methods of storing or accessing information that are not patentably distinct from each other as they all perform the same function as discussed in the specification as filed page 4 lines 1-11 wherein applicant is discussing "Basic Software Structure" and "Resource Libraries". Accordingly they are rejected here in toto for such reason. As indicated and described in the Background Art section of the specification, these various resource libraries are nothing more than art recognized equivalents and as such would be obvious to utilize each and every library accessible by each, every or any platform, operating system or operating method.

Regarding claim 95 - Wyman discloses the apparatus of claim 87 wherein said access authorization indicator is specified in a constant declaration area of said software program (e.g. col 6 ln 48-62).

Regarding claim 96 - Wyman discloses the apparatus of claim 87 wherein said access authorization indicator comprises a property of a property list of said software program (e.g. Figures 2, 4 and col. 14, lines 12+).

Regarding claim 97 - Wyman discloses the apparatus of claim 85 further comprising an identifier associated with said access authorization indicator and wherein said means for determining the validity of said access authorization indicator comprises means for determining whether said access authorization indicator is valid based on said identifier (e.g. Abstract, and col 7 ln 2-40).

Regarding claim 98 - Wyman discloses the apparatus of claim 97 further comprising means for receiving said identifier from an end user (e.g. col 7 ln 30-33)

Regarding claim 99 - Wyman discloses the apparatus of claim 98 further comprising means for storing said identifier in said software resource (e.g. col 7 ln 37-40).

Regarding claim 100 - Wyman discloses the apparatus of claim 97 wherein said identifier is embedded in said software program (e.g. col 7 ln 29-35).

Regarding claim 101 - Wyman discloses the apparatus of claim 100 wherein said identifier is specified in a constant declaration area of said software program (e.g.

col 7 ln 29-35) wherein it is understood that under current programming methods such specification of constants is done in said constant declaration area.

Regarding claim 102 - Wyman discloses the apparatus of claim 100 wherein said identifier comprises a property of a property list of said software program (e.g. Figures 2, 4 and col. 14, lines 12+).

Regarding claim 103 - Wyman discloses the apparatus of claim 97 wherein said means for determining whether said access authorization indicator is valid based upon said identifier comprises a means for digital signature authentication (e.g. col 12 ln 54-60).

Regarding claim 104 - Wyman discloses the apparatus of claim 85 further comprising means for determining whether said one or more license terms are met (e.g. col 8 ln 32-40).

Regarding claim 105 - Wyman discloses the apparatus of claim 97 wherein said software program comprises said access authorization indicator and said identifier; said access authorization indicator comprises terms of a license for use of said software resource; said identifier comprises a digital signature of said access authorization indicator (e.g. col 12 ln 54-60).

NOTE: claims 106-147 mirror the apparatus disclosed in claims 84-92 and 94-105. Since the method and storage device embodying the program to perform said method are disclosed in said claims 106-147 the rejections will NOT be repeated. However the Examiner has mapped out how the claims correspond to which apparatus claims, however the claims can and are rejected for at least the reasons set forth in the base claim as Wyman clearly sets forth the method and system and means for storing said method within his specification as set forth above as well as within his claims 1-31.

Claims 106 and 127 are in parallel with claim 84.

Claims 107 and 128 are in parallel with claim 85.

Claims 108 and 129 are in parallel with claim 86.

Claims 109 and 130 are in parallel with claim 87.

Claims 110 and 131 are in parallel with claim 88.

Claims 111 and 132 are in parallel with claim 89.

Claims 112 and 133 are in parallel with claim 90.

Claims 113 and 134 are in parallel with claim 91.

Claims 114 and 135 are in parallel with claim 92.

Claims 115 and 136 are in parallel with claim 94.

Claims 116 and 137 are in parallel with claim 95.

Claims 117 and 138 are in parallel with claim 96.

Claims 118 and 139 are in parallel with claim 97.

Claims 119 and 140 are in parallel with claim 98.

Claims 120 and 141 are in parallel with claim 99.

Claims 121 and 142 are in parallel with claim 87.

Claims 122 and 143 are in parallel with claim 95.

Claims 123 and 144 are in parallel with claim 96.

Claims 124 and 145 are in parallel with claim 103.

Claims 125 and 146 are in parallel with claim 104.

Claims 126 and 147 are in parallel with claim 105.

11. Claims 84-92 and 94-104 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ross (U.S. Patent 5,553,143) in view of Applicants Admitted Prior Art (APA).

Regarding claim 84 - Ross discloses, in a computer operating environment comprising a software program and a software resource, an apparatus for limiting use of said software resource by said software program and a software resource, comprising: means for using an access authorization indicator associating a software program and a software resource, said access authorization indicator comprising a plurality of license terms to allow said software program to use said software resource; and a digital signature of said access authorization indicator in, for example, the abstract, Figures 1-9, col. 1 lines 49+ through col. 2 line 17, col. 4 lines 1-10 and col. 6 lines 1-16.

Regarding claim 85 - Ross discloses the apparatus of claim 84 further comprising: means in said software resource for reading said access authorization indicator; means in said software resource for determining whether said access authorization indicator is valid; and, means for allowing said software program to use said software resource only if said access authorization indicator is determined to be valid in, for example, Col 1 In 50 wherein it is understood that in order to enforce software licenses such determinations must be made, i.e. the indicator must be read and validity determined in order to "enforce" the license.

Regarding claim 86 - Ross discloses the apparatus of claim 84 wherein said access authorization indicator comprises terms of a site license in, for example, Col 17 lines 30+ through col. 18 line 50 (line 62 specifically discloses site license).

Regarding claims 87 and 100 - Ross discloses the apparatus of claim 84 wherein said access authorization indicator is embedded in said software program in, for example, Col 2 lines 56-60 wherein it is understood that it was known to do so previously and therefore it would be obvious to do so again in the future.

Regarding claim 88 - Ross discloses the apparatus of claim 84 wherein said software resource comprises an API in for example claim 1 wherein it is understood that storing the licenses in a database in a second computer can be done in any of

the methods disclosed as such is nothing more than an art level equivalent for storing and retrieving data.

Regarding claims 88-92, 94, 110-115 and 131-136 it must be noted that these claims are all directed towards obvious variants of computer related methods of storing or accessing information that are not patentably distinct from each other as they all perform the same function as discussed in the specification as filed page 4 lines 1-11 wherein applicant is discussing "Basic Software Structure" and "Resource Libraries". Accordingly they are rejected here in toto for such reason. As indicated and described in the Background Art section of the specification, these various resource libraries are nothing more than art recognized equivalents and as such would be obvious to utilize each and every library accessible by each, every or any platform, operating system or operating method.

Regarding claims 95 and 101 - Ross discloses the apparatus of claim 87 wherein said access authorization indicator is specified in a constant declaration area of said software program in, for example, col 3 In 3-20 and col 3 lines 1-10 wherein it is understood that the constant associated with which license the current application is running on must be defined and is usually done in a constant declaration area of the program.

Regarding claims 96 and 102 - Ross discloses the apparatus of claim 87 wherein said access authorization indicator comprises a property of a property list of said software program in, for example, col 4 lines 1-10 wherein it is understood that the list of properties includes whether the license is an anchor, upgrade or companion.

Regarding claim 97 - Ross discloses the apparatus of claim 85 further comprising an identifier associated with said access authorization indicator and wherein said means for determining the validity of said access authorization indicator comprises means for determining whether said access authorization indicator is valid based on said identifier in, for example col. 19 claim 15.

Regarding claim 98 - Ross discloses the apparatus of claim 97 further comprising means for receiving said identifier from an end user because if said identifier is not received then said comparison cannot be made.

Regarding claim 99 - Ross discloses the apparatus of claim 98 further comprising means for storing said identifier in said software resource because if the identifier is not stored then it cannot be used or processed as it would be lost from the system.

Regarding claim 103 - Ross discloses the apparatus of claim 97 wherein said means for determining whether said access authorization indicator is valid based

upon said identifier comprises a means for digital signature authentication in, for example, col 18, line 22.

Regarding claim 104 - Ross discloses the apparatus of claim 85 further comprising means for determining whether said one or more license terms are met in for example col. 1 lines 49-50 wherein it is understood that such is required in order to enforce licenses.

Regarding claim 105 - Ross discloses the apparatus of claim 97 wherein said software program comprises said access authorization indicator and said identifier; said access authorization indicator comprises terms of a license for use of said software resource; said identifier comprises a digital signature of said access authorization indicator in, for example Appendix A spanning columns 17 and 18.

NOTE: claims 106-147 mirror the apparatus disclosed in claims 84-92 and 94-105. Since the method and storage device embodying the program to perform said method are disclosed in said claims 106-147 the rejections will NOT be repeated. However the Examiner has mapped out how the instant applications claims correspond to which apparatus claims, however the claims can and are rejected for at least the reasons set forth in the base claim as Ross clearly sets forth the method

and system and means for storing said method within his specification as set forth above as well as within his claims 1-40.

Claims 106 and 127 are in parallel with claim 84.

Claims 107 and 128 are in parallel with claim 85.

Claims 108 and 129 are in parallel with claim 86.

Claims 109 and 130 are in parallel with claim 87.

Claims 110 and 131 are in parallel with claim 88.

Claims 111 and 132 are in parallel with claim 89.

Claims 112 and 133 are in parallel with claim 90.

Claims 113 and 134 are in parallel with claim 91.

Claims 114 and 135 are in parallel with claim 92.

Claims 115 and 136 are in parallel with claim 94.

Claims 116 and 137 are in parallel with claim 95.

Claims 117 and 138 are in parallel with claim 96.

Claims 118 and 139 are in parallel with claim 97.

Claims 119 and 140 are in parallel with claim 98.

Claims 120 and 141 are in parallel with claim 99.

Claims 121 and 142 are in parallel with claim 87.

Claims 122 and 143 are in parallel with claim 95.

Claims 123 and 144 are in parallel with claim 96.

Claims 124 and 145 are in parallel with claim 103.

Claims 125 and 146 are in parallel with claim 104.

Claims 126 and 147 are in parallel with claim 105.

Conclusion

12. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims **for the convenience of the applicant**. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, **other passages and figures may apply as well.** It is respectfully requested from the applicant, in preparing the responses, to fully **consider the references in entirety** as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Fri 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2006-11-09

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